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ALSTON & BIRD LLP			EVANS, KIMBERLY L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/696,180	MYRICK ET AL.
	Examiner	Art Unit
	KIMBERLY EVANS	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>7/20/05;7/21/05;8/9/05;4/14/08</u>	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on October 28, 2003.
2. In reference to communication received on November 7, 2008, where applicant elects to prosecute claims 1-19 of Group 1: "...Applicant hereby elects to prosecute the claims of Group I (Claims 1-19); claims 20-86 are hereby deemed cancelled.
3. Claims 1-19 are currently pending and have been examined.

Information Disclosure Statement

4. The Information Disclosure Statements filed on July 20, 2005, July 21, 2005, August 9, 2005, and April 14, 2008 have been considered. An initialed copy is enclosed herewith.

Claim Rejections - 35 USC § 101

5. The following is a quotation of the first paragraph of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. The machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means, reciting a specific machine or a particular transformation of a specific article in an insignificant step such as data gathering or outputting, is not sufficient to pass the test. If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-14, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Simms et al., US Patent Application Publication No US 2005/0104716 A1.

10. With respect to Claim 1,

Simms discloses the following limitations,

- *registering a customer to receive a product at an alternative delivery location (ADL) other than the customer's home or business address before purchase of the product by the customer, (see at least paragraph 10: "...The above and other objects are realized by the present invention, one embodiment of which comprises a storage appliance or device at a fixed site/location/address which is accessible by means of an identifier unlocking a locked entry door... The appliance is capable of receiving and storing goods for delivery or pickup with a level of security preventing unauthorized entry or theft and with protection against pests and unfavorable weather conditions..."; paragraph 33: "...The retailer/vendor 20 electronically looks up and verifies the account of the consumer against a register or database of accounts made available on-line by the scheduler 22. An account holder is an authorized user of an appliance(s) 10 (FIG. 1 only) capable of unattended receipt/delivery and of electronically communicating with a specialized computer program (scheduler) which schedules deliveries to the appliance and reports deliveries to the account holder. The consumer selects items for purchase and delivery and fills an electronic shopping cart...")*
- *shipping the product purchased by the customer to the ADL for pickup by the customer after purchase of the product by the customer. (see at least paragraph 14: "...The method of the present invention may alternately be described as a method of: delivery of ordered items to a plurality of locked storage containers, each associated with a corresponding customer, using a delivery system ..."; paragraph 36: "...The retailer or seller notifies the consumer of the final purchase price including shipping and handling. At step 30, the consumer authorizes the purchase and indicates method of payment. The consumer may arrange for payment to seller directly or by debit or credit accounts linked to the consumer's account. The seller finalizes the*

sale. At block 32, the seller notifies the scheduler 22 (a specialized computer program running on a delivery system computer) of the time/date of the intended delivery and the estimated size of the bundle of items. The scheduler reserves the capacity in the designated appliance for the scheduled time/date of the delivery...”))

11. With respect to Claim 2,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the registering of the customer is performed by the customer accessing a website of an ADL service provider via the Internet using a web browser.* (see at least paragraph 32: “...the customer 18 is linked to website/retail partner 20 which in turn is linked to a scheduler website software 22 and delivery partner 24...”)

12. With respect to Claim 3,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the customer registers by selecting the ADL most convenient to the customer from among a list of ADLs* (see at least paragraph 32: “...The various delivery partners may be specialized on a geographic basis, a delivery basis (i.e., one delivers within one day, another delivers within three days, etc.), and possibly by the type of delivery being made...”; paragraph 40: “...The consumer may review his/her account through a variety of views including available capacity by time period, committed capacity by time period, chronological list of scheduled deliveries, chronological list of scheduled deliveries by vendor, chronological list of scheduled deliveries by vendor classification (i.e., groceries, dry cleaning, etc.), deliveries made, deliveries missed, inventory of items ordered or delivered (by vendor, vendor classification, time period, etc.), inventory of items ordered but not shipped, calculation of costs (by vendor, vendor type, time period, method of payment, shipping and handling, etc.)...”)

13. With respect to Claim 4,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the ADL selected by the customer is stored by a computer system and retrieved from the computer system for use in shipping the product to the customer upon notification to the computer system by a vendor that the customer has purchased the product.* (see at least paragraph 36: "... The retailer or seller notifies the consumer of the final purchase price including shipping and handling. At step 30, the consumer authorizes the purchase and indicates method of payment. The consumer may arrange for payment to seller directly or by debit or credit accounts linked to the consumer's account. The seller finalizes the sale. At block 32, the seller notifies the scheduler 22 (a specialized computer program running on a delivery system computer) of the time/date of the intended delivery and the estimated size of the bundle of items. The scheduler reserves the capacity in the designated appliance for the scheduled time/date of the delivery. The seller also electronically provides to the scheduler (in format specified by the scheduler) an inventory of items purchased, itemized prices of each item purchased, itemized shipping and handling costs, and any other information permitted by the scheduler including coupon or "cents off" offers and other advertising and promotional information. This information provided by the seller may be made accessible by the scheduler to the consumer by a variety of means and formats, including computer networks, the Internet, electronic mail, telephone or printed matter...")

14. With respect to Claim 5,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the registering is performed by a customer ordering the product via a vendor website which notifies a carrier that the product is ready to be shipped from the vendor*

to the buyer (paragraph 33: "...Turning now to the flow chart part of FIG. 2, the steps are numbered 28 to 50, steps 40 and 44 being within a common box. At box 28, a consumer accesses an e-commerce website over the Internet to purchase goods for home delivery. The consumer identifies himself/herself as an account holder. The retailer/vendor 20 electronically looks up and verifies the account of the consumer against a register or database of accounts made available on-line by the scheduler 22. An account holder is an authorized user of an appliance(s) 10 (FIG. 1 only) capable of unattended receipt/delivery and of electronically communicating with a specialized computer program (scheduler) which schedules deliveries to the appliance and reports deliveries to the account holder. The consumer selects items for purchase and delivery and fills an electronic shopping cart...")

15. With respect to Claim 6,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the customer purchases the product using a mail order catalog.*(see at least paragraph 34: "...It will be understood that the invention also contemplates delivery of items ordered by telephone, mail, or in person at a retail store...")

16. With respect to Claim 7,

Simms discloses all of the above limitations, Simms further discloses,

- *the registering involves providing identification of at least one retriever authorized by the customer to pick up the product at the ADL, the method further comprising: verifying at the ADL that the retriever is authorized to receive the product.* (see at least paragraph 10: "...The above and other objects are realized by the present invention, one embodiment of which comprises a storage appliance or device at a fixed site/location/address which is accessible by means of an identifier unlocking a locked entry door. (As used herein, an "identifier" includes a physical device, such as a key,

electronic key, smart card, magnetic card, or similar device carried or transported by an individual to give access or a biometric property such as fingerprint, voice pattern as recognized by a machine, or retinal scan of a delivery person. The identifier is associated with a particular person, such as a delivery person, or a particular company....")

17. With respect to Claims 8 and 9,

Simms discloses all of the above limitations, Simms further discloses,

- *notifying the customer that the product is available for pickup at the ADL.*
- *the registering involves the customer providing an indication of a preferred media for receiving notification that the product has arrived at the ADL, the preferred notification media comprising at least one of telephone, email, pager, and the notifying is performed using the customer's preferred media.*

(see at least paragraph 40: "...The scheduler updates the consumer's account with various information regarding each purchase and scheduled delivery at step 50. The consumer may access this information through a variety of means including a computer network, an email, the Internet (i.e., checking a web page), a text message to the consumer's pager, or telephone. The consumer may review his/her account through a variety of views including available capacity by time period, committed capacity by time period, chronological list of scheduled deliveries, chronological list of scheduled deliveries by vendor, chronological list of scheduled deliveries by vendor classification (i.e., groceries, dry cleaning, etc.), deliveries made, deliveries missed, inventory of items ordered or delivered (by vendor, vendor classification, time period, etc.), inventory of items ordered but not shipped, calculation of costs (by vendor, vendor type, time period, method of payment, shipping and handling, etc.)...")

18. With respect to Claims 10 and 11,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein an alternate delivery location tracking system (ATS) notifies the customer of arrival of the product at the ADL.,*
- *wherein the ADL staff notifies the customer that the product is available for pick up at the ADL*

.(see at least Abstract: "... The appliance communicates, such as via the internet, with a remote delivery system computer having a scheduler that schedules deliveries during particular time intervals. Prior to scheduling the delivery, the delivery system computer compares the dimensions of the order with the available space within the appliance of the customer. After a delivery is made, the appliance communicates via the internet that the delivery has been made and the delivery system computer then charges or debits the customer's account for the cost associated with the delivery..."; paragraph 12: "...The appliance receives and transmits data to the computer or computer network (hereinafter referred to as the "scheduler") which is capable of organizing and recording a schedule of deliveries and pickups utilizing the appliance and transmitting instructions to the appliance allowing it to identify an identifier authorized to access the appliance in accordance with a schedule..."; paragraph 37: "...At step 38, the seller electronically provides to the scheduler information to update the order, including any shipping information, routing or tracking numbers, etc., and any additional advertising or promotional information..."; paragraph 39: "...When a delivery is made to the appliance 10 at step 42, the appliance communicates to the scheduler (by sending a "delivery made" signal) that the delivery was completed at step 44. Debit or credit sales at the point of delivery are processed for payment (costs of the goods and/or delivery applied to an account of the customer) at step 46. The scheduler updates the consumer's account with the time/date of receipt. The vendor selling the goods or service making the delivery may also provide information to the customer's account regarding the time/date of delivery...")

19. With respect to Claim 12,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the vendor notifies the customer when the product is available for pick up at the ADL.* (see at least paragraph 39: "...The vendor selling the goods or service making the delivery may also provide information to the customer's account regarding the time/date of delivery, promotional material and other information specified above, including a "thank-you" for the purchase at step 48...")

20. With respect to Claim 13,

Simms discloses all of the above limitations, Simms further discloses,

- *accessing an alternate delivery location tracking system (ATS) to determine the status of the product in shipment from a vendor of the product to the customer.* (see at least paragraph 13: "...Users of the method may schedule delivery, track shipment and delivery, make secure delivery by means of a specialized appliance, make and confirm payment, inventory items scheduled for delivery and delivered...."; paragraph 37: "...the seller electronically provides to the scheduler information to update the order, including any shipping information, routing or tracking numbers, etc., and any additional advertising or promotional information. ...").

21. With respect to Claim 14,

Simms discloses all of the above limitations, Simms further discloses,

- *providing the customer with an authorization number that the customer can use to access the ATS to determine status of the product during transit from the vendor to the ADL.*(see at least paragraph 38: "...Preceding the time/date of each scheduled delivery, the scheduler communicates at step 40 electronic instructions to the appliance to permit entry to delivery personnel using a key which is identified by the

appliance and matches a key authorized for entry for the scheduled delivery at that date/time (a time interval within an assigned date, or optionally, more than one date). If a key does not match a key authorized for entry at that time/date, entry will be denied. Once entry is gained for an authorized key, that key will be locked out until re-authorized...”)

22. With respect to Claim 18,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the customer provides an address of the ADL location as the address for shipping the product in purchasing the product from a vendor.* (see at least paragraph 12: “...The appliance may be identified by the computer or computer network with which it is communicating by identification number, name or location. Each appliance may be associated with a user account record or records...”; paragraph 18: “...Prior to dividing the ordered delivery, input is received from the customer indicating the customer's preference for a complete delivery or delivery in multiple portions; and the scheduler schedules delivery according to the customer's preference...”)

23. With respect to Claim 19,

Simms discloses all of the above limitations, Simms further discloses,

- *wherein the registering involves the customer downloading a web browser enhancement tool that automatically populates the form fields of a web page to provide the ADL address for upload to a vendor computer system via the Internet to*

purchase the product. (see at least Abstract: "...The appliance communicates, such as via the internet, with a remote delivery system computer having a scheduler that schedules deliveries during particular time intervals.."; paragraph 35: "...As the shopping cart is loaded with goods selected, the estimated total size of the bundle of items as measured by the dimensions of height, width and depth is calculated (with software provided by the scheduler) based on information provided by the seller. Accessing information (provided by the scheduler over a computer network of the Internet) regarding the type and capacity of the appliance and the estimated remaining capacity of the appliance at the projected time/date of delivery, the estimated size of the bundle of items is compared against the total volume (including the various dimensions) of space remaining available in the consumer's designated appliance(s) on the time/date of the proposed date of delivery....")

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- (a) Determining the scope and contents of the prior art.
- (b) Ascertaining the differences between the prior art and the claims at issue.
- (c) Resolving the level of ordinary skill in the pertinent art.
- (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.

26. Claims 15-17 are rejected as being unpatentable over Simms et al., US Patent Application Publication No. US 2005/0104716 A1 in view of Fleckenstein et al., US Patent Application Publication No US 2004/0211834 A1.

27. With respect to Claim 15,
Simms discloses all of the above limitations, Simms does not disclose the following limitations, but Fleckenstein however, as shown discloses,

- *wherein the accessing is performed by ADL staff to determine the status of packages sent to, held by, and bound for the ADL.* (see at least paragraph 21: "...agent has obtained information about a delivery modification authorization 400 and the parcels 110, 120. In one embodiment, a delivery notice 20 may be left at the address 123 Elm Street. Such information may be obtained by use of, for example, a data acquisition device 30 that may include a radio frequency identification ("RFID") reader, a barcode scanner, etc....")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated receiving and delivery system of Simms with the delivery system of Fleckenstein because it is an efficient means for indicating delivery status of packages.

28. With respect to Claim 16,

Simms discloses all of the above limitations, Simms does not disclose the following limitations, but Fleckenstein however, as shown discloses,

- *wherein the ATS is used by ADL staff to log the date of arrival of the package at the ADL and to track how long the package has been held by the ADL.(see at least paragraph 95: "...Unless such information is already entered, the driver can also fill out preliminary information such as the date, delivery attempt no., COD status, any other needed information, and will then press "stop complete" on the data acquisition device. This completes the creation of a delivery stop record, which, under one embodiment of the present invention, may include but is not limited to the following data fields: package delivery address, item code, delivery modification authorization code(s), time and date, consignee, COD information, etc....")*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated receiving and delivery system of Simms with the delivery system of Fleckenstein because it is an efficient means for indicating that a delivery has been attempted or that the delivery has been modified.

29. With respect to Claim 17,

Simms discloses all of the above limitations, Simms does not disclose the following limitations, but Fleckenstein however, as shown discloses,

- *wherein the ATS is accessed by the ADL staff using an ADL computer system to record the identity of a retriever of the product.(see at least paragraph 130: "...The customer will provide a delivery notice, a delivery notice number and/or some form of valid identification in order to retrieve the parcel(s) from the service center...")*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated receiving and delivery system of Simms with the delivery system

of Fleckenstein because it is an efficient means for ensuring packages are retrieved by authorized customers.

Conclusion

30. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see [<http://pair-direct.uspto.gov>](http://portal.uspto.gov/external/portal/pair). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks Washington, D.C. 20231** or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

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/Kimberly Evans/Examiner, Art Unit 3629

February 2, 2009

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629